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EXAMINER	
MANSFIELD, THOMAS L	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,283	Applicant(s) BRESLIN ET AL.
	Examiner THOMAS MANSFIELD	Art Unit 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 September 2003_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-30_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _17 September 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _7 October 2007_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This Non-Final Office action is in reply to the Application filed on 17 September 2003.

2. Claims 1-30 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4-11, 15-19, 21-25, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Callahan et al (Callahan) (U.S. Pub. No. 2003/0229525).

6. **CLAIM 1:**

With regard to Claim 1, Callahan teaches a method and system comprising:

- *identifying outside service provider information that describes the outside service provider* (provide a population of all third-party providers and risk-rank them) (see at least paragraph 0028).
- *storing the outside service provider information in a database* (Assessment templates, 612, are also stored in fixed storage) (see at least paragraph 0043).

- *identifying resource information that describes resources of the enterprise associated with services provided by the outside service provider* (the type of data shared between the financial services company and the provider) (see at least paragraph 0028).
- *storing the resource information in the database* (Assessment templates, 612, are also stored in fixed storage) (see at least paragraph 0043).
- *assessing an impact* (impact value) *on the enterprise from a degradation of the services from the outside service provider* (the impact is less critical than if account balances, account numbers, and transactions were revealed) (see at least paragraph 0060).
- *storing the assessment in the database* (Assessment templates, 612, are also stored in fixed storage) (see at least paragraph 0043).
- *automatically determining a criticality of the outside service provider in response to the assessment* (the impact is less critical than if account balances, account numbers, and transactions were revealed) (see at least paragraph 0060).
- *storing the criticality in the database* (Assessment templates, 612, are also stored in fixed storage) (see at least paragraph 0043).
- *providing status data from the database* (SQL database) (see at least paragraph 0055), *wherein the status data comprises at least* ***one*** *of a status of:*
    - *the resource information*
    - *the assessment* (updated to change the status of the assessment) (see at least paragraph 0055).
    - *the criticality* (critical) (see at least paragraph 0060).

7. CLAIM 19:

With regard to Claim 19, Callahan teaches a system, interface, database server, and application server (Microsoft's Internet Information Services) (see at least paragraph 0047). Claim 19 is further substantially similar to claim 1 and is rejected for the same rationale as set forth above.

8. CLAIMS 4 and 21:

With regard to Claims 4 and 21, Callahan teaches *wherein at least one of the resources of the enterprise includes at least one software application employed by the enterprise* (Application Software) (see at least paragraph 0029).

9. CLAIMS 5 and 22:

With regard to Claims 5 and 22, Callahan teaches: *wherein the step of assessing the impact* (threat value, impact value) *on the enterprise further comprises at least* ***one of***:

- *assessing an impact on external customers* (customer's name) (see at least paragraph 0060) *of the enterprise resulting from the degradation of the services from the outside service provider*.
- *assessing an impact on internal customers* (of other areas of the enterprise) (see at least paragraph 0025) *of the enterprise resulting from the degradation of the services from the outside service provider*.
- *assessing a financial impact* (account balances, account numbers, and transactions) *resulting from the degradation of the services from the outside service provider* (see at least paragraph 0060).
- *assessing an allowable time period that the degradation of the services from the outside service provider can last*.

- *assessing an impact on regulatory obligations* (monitoring compliance with the GLBA [Gramm-Leach-Bliley Act (GLBA), paragraph 0002]) *resulting from the degradation of the services from the outside service provider* (see at least paragraph 0020).

10. CLAIMS 6 and 23:

With regard to Claims 6 and 23, Callahan teaches *assigning specific people* (data guardian) *to fulfill roles with respect to management of a relationship with the outside service provider, wherein the roles include at least one of information owner and information risk manager* (see at least paragraph 0034).

11. CLAIMS 7 and 24:

With regard to Claims 7 and 24, Callahan teaches *receiving acknowledgements of the acceptances of the assignments from the specific people* (obtains a sign-off from the approver) (see at least paragraph 0034).

12. CLAIMS 8 and 25:

With regard to Claims 8 and 25, Callahan teaches *assigning alternate people to fulfill the roles* (one or more re-viewers or “data guardians”) (see at least paragraph 0026).

13. CLAIM 9:

With regard to Claim 9, Callahan teaches *wherein the role of the information owner comprises at least* ***one of***:

- *obtaining from the outside service provider copies of financial and non-financial audit reports* (audits) (see at least paragraph 0024).
- *obtaining documentation describing the outside service provider's procedural, physical access, logical access and business recovery controls* (emphasizing those that have access to or who manipulate, store, transmit or

destroy the company's consumer customer information) (see at least paragraph 0028).

- *requiring notification by the outside service provider of any organization, security-related and other changes affecting the availability, confidentiality, or integrity of the services provided by the outside service provider.*
- *initiating the risk assessment process* (The process starts at 201) (see at least paragraph 0026).

14. CLAIM 10:

With regard to Claim 10, Callahan teaches *wherein the role of information risk manager (data guardian) comprises at least* ***one of****:*

- *maintaining an updated list of outside service providers used by the enterprise* (the database is kept updated) (see at least paragraphs 0054-0056).
- *allocating resources for the outside service provider assessment process.*

15. CLAIMS 11 and 30:

With regard to Claims 11 and 30, Callahan teaches *wherein all of the steps of the method are facilitated using a software application* (risk assessment module), *the method further comprising:*

- *generating data input screens for accepting input from a user* (screens that show detail of how comments are entered and risk values are established) (see at least paragraph 0059).
- *providing drop down boxes on the data input screens in order to facilitate selection of predefined information* (a drop-down box, accessed from the tab, displays that progress) (see at least paragraph 0058).

16. CLAIMS 15 and 29:

With regard to Claims 15 and 29, teaches *providing status data on the enterprise level; providing status data on a line of business level; and providing status data on a department level* (handle assessments at whatever level a business unit or the enterprise wants, executives, administrators, senior managers) (see at least paragraph 0032).

17. CLAIM 16:

With regard to Claim 16, Callahan teaches *wherein the enterprise has policies and procedures* (policies and procedures) *for protecting the integrity of the provision of services* (Identify perceivable threats, evaluate the likelihood of those threats), *the method further comprising assessing the compliance* (compliance) *of the outside service provider to the policies and procedures* (see at least paragraph 0025).

18. CLAIM 17:

With regard to Claim 17, Callahan teaches *developing a corrective action plan if the outside service provider is not in compliance, the corrective action plan containing the steps required to bring the outside service provider into compliance* (The assessor works through whatever corrective action needs to be taken on the assessment and re-submits it to the data guardian) (see at least paragraph 0057).

19. CLAIM 18:

With regard to Claim 18, Callahan teaches *obtaining an acknowledgement by management of the enterprise of risk associated with the non-compliance of the outside service provider* (non-compliance is indicated based on a response or group of responses) (see at least paragraph 0023).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

21. Claims 2, 3. 12-14. 20, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callahan as applied to claims 1, 4-11, 15-19, 21-25, 29, and 30 above, in view of Bott (U.S. 6,856,973) and in further view of Borgia et al (Borgia) (U.S. Pub. No. 2002/0129221).

22. **CLAIMS 2 and 20:**

With regard to Claims 2 and 20, Callahan does not specifically teach *identifying countries in which the outside service provider operates and determining a country impact risk associated with the countries, wherein the step of automatically determining the criticality is also in response to the country impact risk*. Bott teaches *identifying countries in which the outside service provider operates and determining a country impact risk* (volatility risk) *associated with the countries, wherein the step of automatically determining the criticality is also in response to the country impact risk* in analogous art of assessing creditworthiness of a country for the purposes of, "[u]nits of government could use their legal empowerment to delay or discontinue transactions" (see at least column 8, lines 10-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the volatility risk of that country as taught by Bott with the integrated compliance monitoring method of Callahan. One of ordinary skill in the art would have been motivated to do so for the benefit of knowing an updated status of a country's ability to maintain a strong economic status (Bott, column 8, lines 10-22).

23. CLAIM 3:

With regard to Claim 3, Callahan does not specifically teach *collecting economic condition information with respect to the country; storing the economic condition information in the database; collecting social condition information with respect to the country; storing the social condition information in the database; collecting political condition information with respect to the country; add storing the political condition information in the database*. Bott teaches *collecting economic* (economic) *condition information with respect to the country; storing the economic condition information in the database* (creating a database of economic scores for the country) (see at least column 1, lines 36-45); *collecting social condition (social) information with respect to the country; storing the social condition information in the database; collecting political condition information with respect to the country; add storing the political condition* (political) (see at least column 4, lines 64-67 and column 5, lines 1-7) *information in the database* in analogous art of assessing creditworthiness of a country for the purposes of, "[f]actors that may interfere with an ability or willingness of a country and its economic agents to honor their financial or contractual obligations to non-resident owners…) (see at least column 5, lines 2-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the economic and risk factors of a country as taught by Bott with the integrated compliance monitoring method of Callahan. One of ordinary skill in the art would have been motivated to do so for the benefit of implementing a country risk assessment system (Bott, column 4, lines 64-67).

24. CLAIMS 12 and 26:

With regard to Claims 12 and 26, Callahan and Bott do not teach *assessing a recovery plan of the outside service provider*. Borgia teaches *assessing a recovery plan* (plan accessible to a crisis team for recovery) *of the outside service provider* (see at least paragraph 0043) in analogous art of tracking compliance with policies related to management of risk for the purposes of "…an information policy provides the requirements for disaster recover preparedness" (see at least paragraph 0043).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disaster recover preparedness plan as taught by Borgia with the economic and risk factors of a country as taught by Bott and the integrated compliance monitoring method of Callahan. One of ordinary skill in the art would have been motivated to do so for the benefit of un-interrupted business process due to a backup recovery plan (Borgia, paragraph 0043).

25. CLAIMS 13 and 27:

With regard to Claims 13 and 27, Callahan and Bott do not teach *questioning the developer of the plan as to whether it has required elements; and developing a corrective action plan to address missing required elements*. Borgia teaches *questioning the developer* (risk management assessor) *of the plan as to whether it has required elements* (consisting of a series of questions that must be answered with appropriate responses to product compliance) *and developing a corrective action plan to address missing required elements* (reviews areas of non-compliance and the associated risk acknowledgements to provide approval if appropriate) in analogous art of tracking compliance with policies related to management of risk for the purposes of " having an approved process or plan in place to achieve compliance" (see at least paragraphs 0043-0057).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disaster recover preparedness plan as taught by Borgia with the economic and risk factors of a country as taught by Bott and the integrated compliance monitoring method of Callahan. One of ordinary skill in the art would have been motivated to do so for the benefit of increased awareness and corrective measures for missing elements or non-compliance with a business institution (Borgia, paragraphs 0043-0057).

26. CLAIMS 14 and 28:

With regard to Claims 14 and 28, Callahan and Bott do not teach *an alternate site for providing the services; and a business continuity plan for resumption of the services at the alternate site*. Borgia teaches *an alternate site for providing the services* (may depend upon such factors as whether information is stored off site on a regular basis) *and a business continuity plan for resumption of the services at the alternate site* (Once risk is acknowledged, a plan for reducing the risk or bringing the project into compliance can be formulated) in analogous art of tracking compliance with policies related to management of risk for the purposes of "The rating for disaster recovery readiness may depend upon such factors as whether information is stored off site on a regular basis, intervals in which system backups are made, robustness of computer recovery systems (see at least paragraph 0017).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disaster recover preparedness plan as taught by Borgia with the economic and risk factors of a country as taught by Bott and the integrated compliance monitoring method of Callahan. One of ordinary skill in the art would have been motivated to do so for the benefit of survivability due to a disaster by having an alternate backup (Borgia, paragraph 0017).

Conclusion

27. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Bladen et al (U.S. Pub. No, 2002/0099586) discloses a method, system, and computer program product for risk assessment and risk management.
- Buddle et al (U.S. 6,912,502) discloses a system and method for compliance management.
- Aubert et al, “Assessing the Risk of IT Outsourcing”, Proceedings of the 31st Annual Hawaii International Conference on System Sciences, 1998, discloses to identify the main undesirable outcomes that may result from an IT outsourcing deal.
- Alleman, “Risk Assessment Template for Software Development or Acquisition Projects", Niwot Ridge Consulting, Revision D, 20 February 2001, discloses the foundations for conducting a risk assessment of a large-scale system development project.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3623

21 February 2008
Thomas Mansfield

/Beth Van Doren/
Primary Examiner, Art Unit 3623